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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,739	12/05/2003	Eric G. Hull	427600700087	3999

7590

11/21/2006

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EXAMINER

RODRIGUEZ, RUTH C

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/729,739

Applicant(s)

HULL ET AL.

Examiner

Ruth C. Rodriguez

Art Unit

3677

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


**ROBERT J. SANDY
PRIMARY EXAMINER**

Continuation of 11. does NOT place the application in condition for allowance because: The Applicant argues that the finality of the last Office Action. The Examiner fails to be persuaded by this argument because independent claims 1, 12 and 19 were amended to include new limitations that were not presented in the claims previously. Regarding to the use of new references being used to reject the claims 1, 12 and 19, these claims contain at least one new issue limitation in them, these claims were not cited as allowable in the prior Office Action, the applicant amended the claims only to overcome the rejection of the claims and adding these new limitations allows the use of new references to reject the claims.

The Applicant argues that unamended claims 9, 17 and 24 were improperly rejected because these claims were not modified. The Examiner fails to be persuaded by this argument because the new rejection was necessary due to the modification of the independent claim and not because of the lack of modification of these claims. The newly recited reference is necessary to reject these claims because the newly cited reference used to reject claims 1, 12 and 19 does not contain these features and the use of a secondary reference that teaches the missing features was necessary.

The next argument presented is that "one-piece" does not require search for a new reference especially a two-piece fitting used to reject the claims. The Examiner fails to be persuaded because "a one-piece fitting" is considered a new limitation that was used to overcome the rejection and does require new search. In response to Applicant's argument that Bladh includes additional structure not required by Applicant's invention, it must be noted that Bladh discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant. The other member of the two piece fitting is not considered as part of the one-piece fitting being used to reject the claims since only member 6 is being used as the one-piece fitting.

Regarding to the recitation of the "concrete form", it has been held that the recitation with respect to the matter in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex part Masham, 2 USPQ2d 1647 (1987).

The Applicant argues that Bladh fails to disclose a peripheral wall and an endwall free of openings therethrough. The Examiner fails to be persuaded by this argument because the top portion of the socket disclosed by Bladh is the endwall and the endwall is free of openings. The claim limitation are met because the only opening being shown are the spaces between the fingers that are extending radially inwardly from the endwall and therefore are not part of the endwall.

In response to the Applicant's argument that Bladh does not include features of Applicant's invention, the limitations on which the Applicant relies (i.e., allow entry of concrete through the slots 15) are not stated on the claims. It is the claims that define the claimed invention, and it is the claims, not specifications that are anticipated or unpatentable. Constant v. Advanced Micro-Devices Inc., 7 USPQ 2d. Especially since the openings or slots are not in the peripheral wall or the endwall and the claim only recites that " said body peripheral wall and endwall being continuous and free of openings therethrough around said socket to preclude entry of poured concrete into said socket and said cavity through said body peripheral wall and endwall. The claim does not require precluding entry of the poured concrete through the openings or slots being used to define the fingers as disclosed by Bladh and therefore Bladh meets the claim limitations.